

Attorney Docket No.: **DEX-0548**
Inventors: **Macina et al.**
Serial No.: **10/538,001**
Filing Date: **March 17, 2006**
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REMARKS

Claims 1-18 were pending in the instant application. Claims 11-14 have been withdrawn from consideration by the Examiner and subsequently canceled without prejudice by Applicants herein. Claims 1-10 and 15-18 have been rejected. Claims 1, 7, 15, 16, 17 and 18 have been amended. Support for amendments is provided in the specification at page 23-24 and page 33. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of these amendments and the following remarks.

I. Finality of Restriction Requirement

The Examiner has made final the Restriction Requirement mailed October 4, 2007. Accordingly, in an earnest effort to advance the prosecution of this case, Applicants have canceled without prejudice non-elected claims 11-14. Further, Applicants have amended claim 15-18 to delete non-elected subject matter. Applicants reserve the right to file a divisional application to the non-elected subject matter.

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II. Rejection of Claims 1-10 and 15-18 under 35 U.S.C. 112, second paragraph

Claims 1-10 and 15-18 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner suggests that claims 1 and 15-18 are vague and indefinite because they claim more than was elected. Further, the Examiner suggests that recitation of "selectively hybridizes to" in claims 1, 7, 15 and 16 is vague, indefinite and incomplete. In addition, the Examiner suggests that claims 16, 17 and 18 are incomplete as depending upon canceled claim 12.

Accordingly, in an earnest effort to advance the prosecution of this case, claims 1 and 15-18 have been amended to be drawn to the elected subject matter.

Further claim 1 and claims 15 and 16 have been amended to delete part (c) drawn to a nucleic acid molecule that selectively hybridizes to the nucleic acid molecule of (a) or (b). Claim 7 has also been amended to recite a method wherein step (a) comprises contacting the sample with the nucleic acid molecule of claim 1 under stringent conditions in which the nucleic acid molecule will hybridize to a breast specific nucleic acid. Support for the

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amendment is provided at pages 23-24 wherein detailed methodologies for contacting a nucleic acid molecule under stringent conditions so that the nucleic acid molecule hybridizes to a breast specific nucleic acid are disclosed.

Finally, claims 16, 17 and 18 have been amended to depend on pending claim 1.

Withdrawal of these rejections is therefore respectfully requested.

III. Rejection of Claims 1-10 and 15-18 under 35 U.S.C. 102(b)

Claims 1-10 and 15-18 have been rejected under 35 U.S.C. 102(b) as being anticipated by Rosen et al. (WO 00/55350). The Examiner suggests that SEQ ID NO: 143 encodes a polypeptide that is 95.3% identical to SEQ ID NO:174 of the instant claims.

Applicants respectfully disagree with the Examiner's assertion that SEQ ID NO: 143 of Rosen et al. anticipates claims 1-10 and 15-18. The sequence alignment provided by the Examiner shows SEQ ID NO: 143 of Rosen has overall identity of 95.3% to SEQ ID NO:174. However, due to the gaps in the alignment, SEQ ID NO: 143 of Rosen does not encode SEQ ID NO:174 or have at least 95% sequence identity to a nucleic acid sequence that encodes to SEQ ID NO:174. Therefore, Rosen et al. does not anticipate the claimed invention.

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However, in an earnest effort to advance prosecution of this case, claim 1 has been amended to be drawn to a nucleic acid molecule having at least 98% sequence identity to the nucleic acid molecule of (a) or (b). Support for this amendment is provided at page 33 of the specification. This amendment renders moot this rejection.

Withdrawal is therefore respectfully requested.

IV. Rejection of Claims 1-3, 6, 8 and 9 under 35 U.S.C. 102(b)

Claim 1-3, 6, 8 and 9 have been rejected under 35 U.S.C. 102(b) as being anticipated by GenBank Accession No. BE791925 (September 20, 2000). The Examiner suggests that GenBank Accession No. BE791925 encodes a polypeptide that is 95.3% identical to SEQ ID NO:174 of the instant claims.

It is respectfully pointed out that claim 1 has been amended to be drawn to a nucleic acid molecule having at least 98% sequence identity to the nucleic acid molecule of (a) or (b). Support for this amendment is provided at page 33 of the specification. This amendment renders moot this rejection.

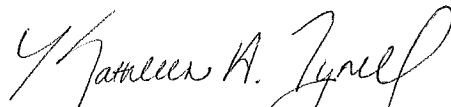
Withdrawal is therefore respectfully requested.

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V. Conclusion

Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



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